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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/608,981

06/27/2003

Robert Keane

MPJ-D2

6395

37420 7590 03/12/2007

VISTA PRINT USA INC.  
ATTN: PATENT COUNSEL  
100 HAYDEN AVENUE  
LEXINGTON, MA 02421

EXAMINER

LAstra, DANIEL

ART UNIT

PAPER NUMBER

3622

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

03/12/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/608,981	<b>Applicant(s)</b> KEANE ET AL.	
	<b>Examiner</b> DANIEL LASTRA	<b>Art Unit</b> 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>09/08/2003</u> . | 6) <input type="checkbox"/> Other: _____  |

Art Unit: 3622

### DETAILED ACTION

1. Claims 1-8 have been examined. Application 10/608,981 (PRODUCT PRICING SYSTEM AND METHOD) has a filing date 06/27/2003 is a division of 09557571 (Pat. 6650433) (04/25/2000) and foreign priority 01/25/2000.

#### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 3 recites the limitation "the customer". Claim 4 recites "the business".

There is insufficient antecedent basis for these limitations in the claims.

#### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-5, 7 and 8 are rejected under 35 U.S.C. 102(e) as being anticipated by

Ryan (US 6,173,274).

Claim 1, Ryan teaches:

A computer-implemented product design method comprising providing one or more product design software tools, the tools being adapted to (a) allow a user to create an electronic product design (see col 12, lines 22-35) and (b) incorporate into the design

Art Unit: 3622

an advertisement not provided by the user, and offering the user the option of removing the advertisement (see col 9, lines 10-25)

Claim 2, Ryan teaches:

The method of claim 1 wherein the tools are further adapted to provide a product template to the user and allow the user to incorporate user content into the template to create the electronic product design and wherein the advertisement is incorporated into the template (see col 9, lines 10-25)

Claim 3, Ryan teaches:

The method of claim 1 wherein the customer must pay a fee to have the advertisement removed (see col 9, lines 10-25; col 10, lines 5-15)

Claim 4, Ryan teaches:

The method of claim 1 wherein the tools are provided to the user at no charge and wherein the advertisement is a promotional message for the business providing the tools (see col 9, lines 10-25)

Claim 5, Ryan teaches:

The method of claim 1 wherein the electronic product design is the design of a product that the user desires to be produced in physical form and wherein the method further comprises offering to produce the physical product for the user at a first price if the advertisement appears on the produced product (see col 9, lines 10-25; col 10, lines 5-15); and

Art Unit: 3622

offering to produce the physical product for the user at a second price if the advertisement does not appear on the produced product, the second price being greater than the first price (see col 9, lines 10-25; col 10, lines 5-15).

Claim 7, Ryan teaches:

The method of claim 5 wherein the electronic product design is the design of a product intended to be printed and the physical product is a quantity of printed copies of the printed product (see figure 1, item 17).

Claim 8, Ryan teaches:

A computer-implemented method for offering to produce products in physical form from an electronic product design prepared by a user, the method comprising offering to produce the physical product at a first price if advertising not provided by the user is incorporated in the electronic product design such that the advertising will appear on the product when the product is produced (see col 9, lines 10-25; col 10, lines 5-15), and

offering to produce the physical product at a second price if advertising not provided by the user is not included in the electronic product design, the first price being lower than the second price (see col 9, lines 10-25; col 10, lines 5-15).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ryan (US 6,173,274).

Claim 6, Ryan does not expressly teach:

The method of claim 5 wherein the first price is free. However, Official Notice is taken that it is old and well known in the promotion art that advertisers offer consumers products or services for free when said consumers accept to view or display advertisements in said products. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that advertisers in the Ryan's system would subsidize certain printing jobs by offering certain printing for free, as it is old and well known to offer user free products when said users are willing to view or display advertisements in said products.

### ***Conclusion***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.

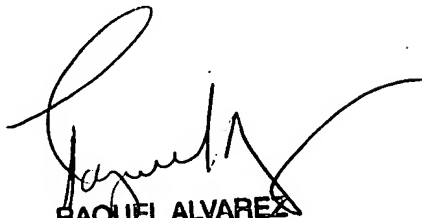
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W. STAMBER can be reached on 571-272-6724. The official Fax number is 571-273-8300.

Art Unit: 3622

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DL

Daniel Lastra  
March 3, 2007

  
**RAQUEL ALVAREZ**  
**PRIMARY EXAMINER**